

### **REMARKS**

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 1-15 are pending in the application. Claims 16-20, added in the submission furnished with the RCE filed on July 12, 2004, are canceled. Claims 1 and 8 are independent. Claims 1 and 8 are amended.

Reconsideration of this application, as amended, is respectfully requested.

### **Drawings**

It is respectfully submitted that the drawings comply with U.S.P.T.O. requirements. Accordingly, a form PTO-948, indicating the drawings have been approved by the Official Draftsperson, is respectfully requested.

### **Claim Rejections under 35 U.S.C. 103(a)**

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants admitted prior art (APA) in view of U.S. patent 6,078,365 to Ueda et al. (hereinafter, "Ueda"). This rejection is respectfully traversed.

In the first place, Applicant has not admitted that Figures 1-5 are prior art to them. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ

743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 1-5 as “Conventional” art. Something can be conventional art in the sense that it is practiced in the real world at the time of Applicant’s filing of this Application and may yet not be prior art to Applicant in any sense, including, for example, under 35 USC §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 USC 103(c).

Under the circumstances, i.e., where Applicant merely describes Figs. 1-5 as conventional art, the Office Action has not established that Applicant has made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 1-5 is prior art to Applicant. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a prima facie case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the

applicant is entitled to the patent. Only when a prima facie case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a prima facie case of unpatentability at least because it has not made out a prima facie case that Figs. 1-5 are prior art to Applicant.

Independent claim 1 recites a combination of elements in a liquid crystal display device, including “a second semiconductor layer over the first semiconductor layer and having a defined outer edge;

a first metal layer on the second semiconductor active layer and having a defined outer edge, the first metal layer patterned in a same pattern as the second semiconductor layer such that the defined outer edge of the first metal layer and is lined up with the defined outer edge of the second semiconductor layer to define a ~~the~~ separation region; and

source and drain electrodes over the first metal layer, the source and drain electrodes patterned the same as the first metal layer and the second semiconductor layer to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers.”

Independent claim 8 recites a combination of steps in a method of forming of a liquid crystal display device, including “forming a second semiconductor layer over the first semiconductor layer and having a defined outer edge;

forming a first metal layer having a defined outer edge over the second semiconductor layer;

patterning the first metal layer and the second semiconductor layer in a same pattern such that the defined outer edge of the first metal layer and is lined up with the defined outer edge of the second semiconductor layer to define a separation region.”

It is respectfully submitted that the combinations of elements and steps recited in independent claims 1 and 8 are not disclosed or made obvious by the applied art of record including the alleged APA and Ueda et al.

The device claims positively recite structural features which are not found in the alleged admitted prior art or in Ueda. The method claims also recite features that are not disclosed by the alleged admitted prior art or Ueda.

Neither the alleged APA nor Ueda disclose the recited lined up outer edges or abutting (touching) features recited in these claims.

Accordingly, even if it were proper to modify the alleged APA in view of Ueda, the resulting reference combination would not meet, or render obvious, the claimed invention.

The Office Action dated March 23, 2004 relies on Figs. 15A-15F of Ueda et al. However, an inspection of those figures reveals a structure significantly different from that claimed. For example, Ueda does not disclose “source and drain electrodes over the first metal layer, the source and drain electrodes

patterned the same as the first metal layer and the second semiconductor layer to define a first upper portion of the separation region that abuts the lined up outer edges of the first and second semiconductor layers,” as recited in claims 1-7, or “patterning the first metal layer and the second semiconductor layer in a same pattern such that the defined outer edge of the first metal layer ~~and~~ is lined up with the defined outer edge of the second semiconductor layer to define a separation region,” as recited in claims 8-15.

Because neither reference discloses a number of claimed features, as indicated above, they do not render obvious the invention recited in claims 1-15.

Furthermore, Applicants respectfully submit that the Office Action dated March 23, 2004 does not make out a prima facie case of proper motivation to modify the alleged APA in view of Ueda. In other words, the Office Action fails to provide any objective evidence of proper motivation to modify Figs. 1-5, which have not been established to be prior art to Applicant, in view of the secondary reference to Deardorff.

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify

the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Ueda is directed to preventing peeling of a metal mask (col. 2, lines 30-38. However, the “conventional” art disclosed by Applicants is not disclosed as does not

exhibiting that problem. Moreover, just because the references are from the same field of endeavor does not provide proper motivation to modify one in view of the other. A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). In other words, the broad conclusionary statement that “ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation” to modify the alleged APA in view of Ueda is not clear and particular enough to constitute evidence of proper motivation.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of the claimed invention.

In view of the forgoing, it is respectfully submitted that the applied prior art of record, including the alleged APA and Ueda et al. fail to teach or suggest the combination of elements and steps set forth in independent claims 1 and 8. It is believed that independent claims 1 and 8 are allowable. Because the remaining claims depend from these allowable independent claims, they are also allowable for at least the above reasons, as well as for the additional limitations provided

thereby. Thus, all claims are allowable and reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a) are respectfully requested.

### **Additional Cited References**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the Office Action dated March 23, 2004, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.



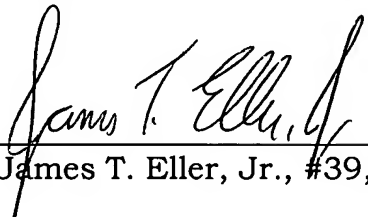
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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